

## **REMARKS**

Applicants have now had an opportunity to carefully consider the Examiner's comments set forth in the Office Action of February 22, 2005.

Reconsideration of the Application is requested.

### **The Office Action**

Claims 1-4, and 6 stand rejected under 35 U.S.C. §102(e) as being anticipated by Baker et al. (U.S. Application No. 2004/0163544 A1). However, Applicants wish to respectfully note that, in the Office Action mailed February 22, 2005, the Examiner made reference to "Baker et al. U.S. Patent 5,408,603." It is assumed by Applicants herein that this was an inadvertent error, in that U.S. Patent No. 5,408,603 was issued to Van de Lavoir, et al., and additionally, the remarks made by the Examiner were consistent with U.S. Application No. 2004/0163544 by Baker et al. (hereinafter Baker).

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Baker as applied to claim 1, and further in view of U.S. Patent No. 5,212,635 issued to Ferriter.

Claims 7-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Baker and U.S. Patent No. 6,321,243 issued to Ballard.

### **The Art Rejections**

#### **Request for Removal of Finality of Office Action and Affirmation of Wherein**

In the Examiner's Response to Arguments, paragraph 6, of the Office Action of February 22, 2005, it is stated that the "applicants assert that Baker is directed towards computer devices, such as a mobile phone or a PDA that is able to access an application program or command based on the selection of corresponding sequences or symbols, whereas on the other hand, independent claims 1 and 6 are directed to a system 'wherein selected ones of the action glyphs, material glyphs and instrumentation glyphs are arranged in relationship to each other in accordance with a predetermined structure to form a specific instruction understandable by the person following the instruction irrespective of the written language understood by the person.'" The same paragraph later states: "With respect to the wherein clause limitation in claims 1 and 6, ... Examiner respectfully notes that claim language such as 'wherein' merely suggests limitations or makes limitations optional. In using claim

language such as 'wherein' applicant has not required steps to be performed or limited an apparatus to a particular structure."

Applicants respectfully traverse the Examiner's opinion that the wherein clause, as recited in original claim 1 is an optional limitation, or can be construed to be optional. Although, as the Examiner pointed out from MPEP §2106, language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or a claim limitation, Applicants submit that the "wherein" clause is listed in MPEP §2106 only as an example of language that may raise a question as to the limiting effect of the language in a claim, as stated in the same section of the MPEP. Applicants respectfully submit that the MPEP does not state that a wherein clause is to be automatically considered as an optional limitation. Applicants further submit that the wherein clause as recited in claim 1 is fully intended to be a required limitation of the claim, particularly with respect to the phrase "to form a specific instruction understandable by the person following the instruction irrespective of the written language understood by the person." Applicants further respectfully request that the Examiner affirm that the limitations of the subject wherein clause of claim 1 are fully considered with regard to patentability over the cited references.

Applicants response to the first Office Action mailed June 28, 2004 was fully responsive to the first Office Action as required by 37 CFR §1.111(b) and MPEP §714.02, however, Applicants were not informed of the issue with the above-described "wherein" clause in that Office Action. Because Applicants were not aware that the Examiner considered the limitations under the wherein clause to be optional, Applicants did not amend independent claim 1 or otherwise argue against the Examiner's position. Applicants, therefore, respectfully request that the Examiner withdraw the finality of the rejection because a clear issue regarding the subject wherein clause was not established between the Examiner and Applicant before the final rejection as required by MPEP §706.7. Applicants appreciate the Examiner's desire to bring the prosecution of the present application to a speedy conclusion, and Applicants share that desire, however, Applicants respectfully request an opportunity to respond to this previously undisclosed issue.

Applicants also note that claim 6 has no wherein clause and, therefore, assume the Examiner's reference to claim 6 was an inadvertent error. Claim 6,

however, includes a limitation of a “predetermined structure to form a specific instruction understandable by the person following the instruction irrespective of the written language understood by the person” which Applicants submit is not taught or suggested in the cited references, as discussed in more detail below.

**Remaining Claims Distinguish over Cited Art**

Applicants respectfully submit, with reference to claims 1 and 6, that the Examiner has not shown in any of the cited references a teaching corresponding to the limitation included in each of claims 1 and 6 that selected ones of the action glyphs, material glyphs and instrumentation glyphs are arranged in relationship to each other in accordance with a predetermined structure to form a specific instruction understandable by the person following the instruction irrespective of the written language understood by the person. Applicants respectfully ask the Examiner to show, and make of record, a disclosure in the cited references that, e.g., the symbols taught by Baker, and referred to by the Examiner in paragraph 2 of the most recent Office Action, represent instructions to be followed by a person who understands the instructions irrespective of the written language understood by the person.

Applicants respectfully submit that the Examiner has misunderstood the Baker reference. Baker does not generate an instruction understandable by the person following the instruction irrespective of the written language understood by the person as recited in claims 1 and 6 of the present application. Rather, in Baker, it is a user that works to generate an input instruction to be performed by a computing system. Further, there is no teaching or suggestion in Baker that a user can understand the symbols regardless of the user's language. For example, on page 15, paragraph 150, Baker discusses the calculator symbol 22a of Figure 1, among other symbols 22b-22f, but each symbol is associated with an English subtitle, thereby indicating a possibility that the user may not understand the symbol. Even the “stop” symbol discussed on page 4, paragraph 40, and shown in Figure 2, contains the English word “stop” to clarify its meaning. There is no suggestion that the stop sign is universally understood by users that only understand non-English languages.

In paragraph 7 of the Examiner's Response to Arguments, it is stated that the Examiner disagrees with Applicant's argument that the symbols taught by Baker are

used for invoking application programs or actions taken by application programs. The Examiner further noted that, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Apparently, the Examiner did not interpret the limitations in claims 1 and 6 regarding the material glyphs and the instrumentation glyphs to represent materials and instruments to be used by the person following the instructions. Therefore, the Examiner apparently likened the glyphs recited in claims 1 and 6 to be similar to the glyphs in Baker which denote actions such as "find" and "move" (which are undertaken by the computer or PDA), and which loosely denote materials such as "eye" and "money," and which further loosely denote instruments such as "keypad." Applicants respectfully submit that the "defined materials" and the "instruments" as recited in claims 1 and 6 represent physical materials and instruments to be used by the person following the instructions—a concept not taught by Baker.

With reference now to claim 3, the Examiner argues that Baker teaches the user creating a command sequence using the symbols "new" representing an action symbol, "all" representing a material symbol, and "file cabinet" representing an instrument symbol. Applicants respectfully submit that "new" does not represent an action, and that the referenced Figures 8c and 8d do not clearly show a glyph representing either "new" or "all." Further, the Examiner provided a dictionary definition of "material" in the Office Action mailed February 22, 2005, and the word "all" does not conform to any of the meanings provided by the *Merriam-Webster* definition. Therefore, Applicants respectfully submit that dependent claim 3 of the present application is patentably distinct over the cited reference.

For the reasons set forth above, Applicants submit that all claims remaining in the present application are in condition for allowance. It is further submitted by Applicants that the aforementioned amendments do not introduce any additional limitations beyond those included in the respective claims as originally filed. The amendments have been made only to clarify and reinforce the intended meaning of the limitations originally filed, and no new material has been added thereby.

Claims 1-9 remain in this application.

**CONCLUSION**

For the reasons detailed above, it is submitted all claims remaining in the application (Claims 1-9) are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

No additional fee is believed to be required for this Amendment After Final. However, the undersigned attorney of record hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Deposit Account No. 24-0037.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call Mark Svat, at Telephone Number (216) 861-5582.

Respectfully submitted,

FAY, SHARPE, FAGAN,  
MINNICH & McKEE, LLP

  
\_\_\_\_\_  
Mark S. Svat  
Reg. No. 34,261  
1100 Superior Avenue, 7<sup>th</sup> Floor  
Cleveland, Ohio 44114-2579  
(216) 861-5582